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SNELL & WILMER LLP 1920 MAIN STREET SUITE 1200 IRVINE, CA 92614-7230			WEST, LEWIS G	
			ART UNIT	PAPER NUMBER
			2682	

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/047,750

**Applicant(s)**

KASHU ET AL.

**Examiner**

Lewis G. West

**Art Unit**

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration:
- 5) ☒ Claim(s) 27-32 is/are allowed.
- 6) ☐ Claim(s) 1-9, 13-21, 25 and 26 is/are rejected.
- 7) ☒ Claim(s) 10-12 and 22-24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8-9-2004</u> . | 6) <input type="checkbox"/> Other: _____  |

***Information Disclosure Statement***

The information disclosure statement filed August 9, 2004 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 13, 14, 25 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Sasakura (US 6,151,493).

Regarding claim 1, Sasakura discloses a mobile phone set including a mobile phone (30) and a mobile warning apparatus (10), wherein the mobile phone (30) transmits a specific electric wave addressed to the mobile warning apparatus (Col. 4 lines 43-48), and the mobile warning apparatus comprises: measuring means (12a) for measuring an electric field strength of the transmitted specific electric wave; judging means (12b) for judging whether the measured value of the electric field strength is smaller than a threshold value (Col. 9 lines 8-16); and warning

Art Unit: 2682

means for giving a warning when the judging means judges that the measured value of the electric field strength is smaller than the threshold value. (Col. 5 lines 8-16)

Regarding claim 3, Sasakura discloses a mobile phone set including a mobile phone and a mobile warning apparatus, wherein the mobile warning apparatus transmits a specific electric wave addressed to the mobile phone (Col. 4 lines 43-48), and the mobile phone comprises: storage means for storing contact information of a predetermined party; measuring means for measuring an electric field strength of the transmitted specific electric wave; judging means for judging whether the measured value of the electric field strength is smaller than a threshold value (Col. 9 lines 8-16); and notifying means for notifying the predetermined party when the judging means judges that the measured value of the electric field strength is smaller than the threshold value. (Col. 5 lines 8-16)

Regarding claim 13, Sasakura discloses a mobile phone set including a mobile phone and a mobile warning apparatus, wherein the mobile warning apparatus transmits a specific electric wave addressed to the mobile warning phone, (Col. 4 lines 43-48), and the mobile warning apparatus includes: instruction receiving means for receiving an operation instruction from a user (Col. 3 lines 59-61); measuring means (12a) for measuring an electric field strength of the transmitted specific electric wave (Col. 7 lines 36-42); judging means (12b) for judging whether the measured value of the electric field strength is smaller than a threshold value (Col. 9 lines 8-16); and control providing means for providing a control to invalidate the operation instruction from the user when the judging means judges that the measured value of the electric field strength is smaller than the threshold value. (Col. 9 lines 8-16),

Art Unit: 2682

Regarding claim 14, Sasakura discloses the mobile phone set of claim 13, wherein the instruction receiving means further receives a personal identification number inputted by the user, and the control providing means includes a control canceling unit for canceling the control upon receiving the personal identification number. (Col. 4 lines 13-28)

Regarding claim 25, Sasakura discloses a mobile phone which receives a specific electric wave transmitted from a mobile warning apparatus, comprising: instruction receiving means for receiving an operation instruction from a user (Col. 3 lines 59-61); measuring means (12a) for measuring an electric field strength of the transmitted specific electric wave (Col. 7 lines 29-43); judging means (12b) for judging whether the measured value of the electric field strength is smaller than a threshold value (Col. 7 lines 29-43); and control providing means (20) for providing a control to invalidate the operation instruction from the user, when the judging means judges that the measured value of the electric field strength is smaller than the threshold value. (Col. 9 lines 8-16)

Regarding claim 26, Sasakura discloses the mobile phone of claim 25, wherein the instruction receiving means further receives a personal identification number inputted by the user, and the control providing means includes a control canceling unit for canceling the control upon receiving the personal identification number. (Col. 4 lines 13-27)

Claims 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Curatolo. (US 6,510,380)

Regarding claim 15, Curatolo discloses a mobile phone which receives a specific electric wave transmitted from a mobile warning apparatus, comprising: storage means for storing contact information of a predetermined party; measuring means for measuring an electric field strength of the transmitted specific electric wave; judging means for judging whether the measured value of the electric field strength is smaller than a threshold value; and notifying means for notifying the predetermined party when the judging means judges that the measured value of the electric field strength is smaller than the threshold value. (Col. 10, EXAMPLE 4)

Regarding claim 16, Curatolo discloses the mobile phone of claim 15, wherein the mobile phone further comprises: acquiring means for acquiring position information showing a position of the mobile phone (GPS receiver); and the notifying means notifies the predetermined party of the position information. (Col. 10, EXAMPLE 4)

Claims 3,4,15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Schlager (US 6,198,390)

Regarding claim 3, Schlager discloses a mobile phone set including a mobile phone and a mobile warning apparatus, wherein the mobile warning apparatus transmits a specific electric wave addressed to the mobile phone, and the mobile phone comprises: storage means for storing contact information of a predetermined party; measuring means for measuring an electric field strength of the transmitted specific electric wave; judging means for judging whether the measured value of the electric field strength is smaller than a threshold value; and notifying

Art Unit: 2682

means for notifying the predetermined party when the judging means judges that the measured value of the electric field strength is smaller than the threshold value. (col. 6 lines 34-52; Col. 7 lines 26-60)

Regarding claim 4, Schlager discloses the mobile phone set of claim 3, wherein the mobile phone further comprises: acquiring means for acquiring position information showing a position of the mobile phone; and the notifying means notifies the predetermined party of the position information. (Col. 10 lines 54-Col. 11 line 13)

Regarding claim 15, Schlager discloses a mobile phone which receives a specific electric wave transmitted from a mobile warning apparatus, comprising: storage means for storing contact information of a predetermined party; measuring means for measuring an electric field strength of the transmitted specific electric wave; judging means for judging whether the measured value of the electric field strength is smaller than a threshold value; and notifying means for notifying the predetermined party when the judging means judges that the measured value of the electric field strength is smaller than the threshold value. (col. 6 lines 34-52; Col. 7 lines 26-60)

Regarding claim 16, Schlager discloses the mobile phone of claim 15, wherein the mobile phone further comprises: acquiring means for acquiring position information showing a position of the mobile phone; and the notifying means notifies the predetermined party of the position information. (Col. 10 lines 54-Col. 11 line 13)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sasakura in view of Wingate (US 6,006,115)

Regarding claim 2, Sasakura discloses the mobile phone set of claim 1, wherein the mobile warning apparatus may be card-shaped, or in any form that is convenient to carry. Sasakura does not expressly disclose using a headphone as an embodiment. However, Wingate discloses a portable electronic device configured as a headphone. (col. 2 lines 28-51; fig. 1,2) Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention as an obvious design choice to use a headphone as a convenient to carry housing, as they are widely used in portable electronic devices as a means to free up a users hands, as it is often inconvenient to constantly carry an object in the hands, and a headphones proximity to the ear would allow for an alarm to be given to the user without disturbing surrounding people.

Claim 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasakura (US 6,151,493) in view of Curatolo (US 6,510,380).

Regarding claim 4, Sasakura discloses the mobile phone set of claim 3, but does not expressly disclose position notification. Curatolo discloses a mobile phone with a notification of



Art Unit: 2682

a separation of a given distance as well as acquiring means for acquiring position information showing a position of the mobile phone; and the notifying means notifies the predetermined party of the position information. (Col. 6 lines 13-39; Col. 10, EXAMPLE 4) Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have a system a system with control canceling based on distance also have location notification in order to aid a user in finding a device taken outside the range of the alarm which may be due to loss or theft thereby aiding in recovery of the device.

Regarding claim 5, the combination of Sasakura and Curatolo discloses the mobile phone set of claim 4, wherein the mobile phone further comprises: instruction receiving means for receiving an operation instruction from a user, and control providing means for providing a control to invalidate the operation instruction from the user, when the judging means judges that the measured value of the electric field strength is smaller than the threshold value. (Sasakura, Col. 8 lines 33-65)

Regarding claim 6, the combination of Sasakura and Curatolo discloses the mobile phone set of claim 5, wherein the instruction receiving means further receives a personal identification number inputted by the user, and the control providing means includes a control canceling unit for canceling the control upon receiving the personal identification number. (Sasakura, Col. 4 lines 13-28)

Claims 7 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlager (US 6,198,390) in view of Root et al (US 6,013,007).

Regarding claim 7, Schlager discloses the mobile phone set of claim 4, wherein the storage means stores a telephone number of a predetermined party and a warning message, and the notifying means includes: audio generating means for reading the warning message from the storage means, and generating audio data for the warning message, according to the warning message and the position information acquired by the acquiring means; connecting means for connecting the predetermined party by reading out the telephone number from the storage means, and by calling the telephone number (Col. 10 lines 45-53); and audio outputting means for outputting the audio data generated by the audio generating means. (Col. 7 lines 6-50), but does not expressly disclose generating and outputting audio data for the position information. Root discloses a portable personal electronic device that combines output audio data including positional (GPS) data as audio. (Col. 5 lines 36-65) Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to output alarm and positional data as audio in order that the user does not have to look at a screen to get the information and further it would be useful to people with impaired sight.

Regarding claim 19, Schlager discloses the mobile phone of claim 16, wherein the storage means stores a telephone number of a predetermined party and a warning message, and the notifying means includes: audio generating means for reading the warning message from the storage means, and generating audio data for the warning message according to the warning message and the position information acquired by the acquiring means; connecting means for connecting the predetermined party by reading out the telephone number from the storage means, and by calling the telephone number (Col. 10 lines 45-53); and audio outputting means for outputting the audio data generated by the audio generating means. (Col. 7 lines 6-50), but does

Art Unit: 2682

not expressly discloses generating and outputting audio data for the position information. Root discloses a portable personal electronic device that combines output audio data including positional (GPS) data as audio. (Col. 5 lines 36-65) Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to output alarm and positional data as audio in order that the user does not have to look at a screen to get the information and further it would be useful to people with impaired sight.

Claims 8, 9, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlager in view of Root and further in view of Sasakura.

Regarding claim 8, the combination of Schlager and Root discloses the mobile phone set of claim 7, but does not discloses invalidation. Sasakura discloses a system wherein the mobile phone further comprises: instruction receiving means for receiving an operation instruction from a user, and control providing means for providing a control to invalidate the operation instruction from the user, when the judging means judges that the measured value of the electric field strength is smaller than the threshold value. (Sasakura, Col. 8 lines 33-65) Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to disable a phone when separated from the user in order to prevent unauthorized use.

Regarding claim 9, the combination of Schlager and Root and Sasakura discloses the mobile phone set of claim 8, wherein the instruction receiving means further receives a personal identification number inputted by the user, and the control providing means includes a control

Art Unit: 2682

canceling unit for canceling the control upon receiving the personal identification number.

(Sasakura, Col. 4 lines 13-28)

Regarding claim 20, the combination of Schlager and Root discloses the mobile phone of claim 19, but does not disclose control invalidation. Sasakura discloses instruction receiving means for receiving an operation instruction from a user, and control providing means for providing a control to invalidate the operation instruction from the user, when the judging means judges that the measured value of the electric field strength is smaller than the threshold value. (Sasakura, Col. 8 lines 33-65) Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to disable a phone when separated from the user in order to prevent unauthorized use.

Regarding claim 21, the combination of Schlager and Root and Sasakura discloses the mobile phone of claim 20, wherein the instruction receiving means further receives a personal identification number inputted by the user, and the control providing means includes a control canceling unit for canceling the control upon receiving the personal identification number. (Sasakura, Col. 4 lines 13-28)

Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Curatolo in view of Sasakura.

Regarding claim 17, Curatolo discloses the mobile phone of claim 16, wherein the mobile phone further comprises means for invalidating operations of a device remotely based on a separation, but does not expressly disclose disabling a mobile phone. Sasakura discloses instruction receiving means for receiving an operation instruction from a user, and control

Art Unit: 2682

providing means for providing a control to invalidate the operation instruction from the user, when the judging means judges that the measured value of the electric field strength is smaller than the threshold value. (Sasakura, Col. 8 lines 33-65) Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to disable a phone when separated from the user in order to prevent unauthorized use.

Regarding claim 18, the combination of Curatolo and Sasakura discloses the mobile phone of claim 17, wherein the instruction receiving means further receives a personal identification number inputted by the user, and the control providing means includes a control canceling unit for canceling the control upon receiving the personal identification number. (Sasakura, Col. 4 lines 13-28)

***Allowable Subject Matter***

Claims 10-12 and 22-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 27-32 are allowable.

Regarding claim 27, discloses a mobile phone which receives a specific electric wave transmitted from a mobile warning apparatus, comprising: storage means for storing contact information of a predetermined party; instruction receiving means for receiving, from a user, a setting instruction for a first mode and a setting instruction for a second mode, each of the first and second modes having a threshold value for an electric field strength of the specific electric

Art Unit: 2682

wave; mode storage means for storing, in correspondence, a mode which is set to be on by the user, and the threshold value, measuring means for measuring the electric field strength for the specific electric wave; first judging means for judging, when the first mode is set to be on, whether the measured value of the electric field strength is smaller than the threshold value for the first mode; second judging means for judging, when the second mode is set to be on, whether the measured value of the electric field strength is smaller than the threshold value for the second mode; notifying means for notifying the predetermined party when the first judging means judges that the measured value of the electric field strength is smaller than the threshold value; and warning means for giving a warning when second judging means judges that the measured value of the electric field strength is smaller than the threshold value.

Claim 28 depends from claim 27 and is therefore allowable based on this dependence.

When incorporating all the limitations of the base claim and any intervening claims, none of the prior art discloses the features as claimed.

Regarding claim 29, discloses a mobile phone system comprising a reception apparatus located at a remote security company and the mobile phone which receives a specific electric wave and which is carried, by a user, with a mobile warning apparatus transmitting a specific electric wave to the mobile phone, the mobile phone comprising: measuring means for measuring an electric field strength of the specific electric wave; judging means for judging whether the measured value of the electric field strength is smaller than the threshold value; notifying means for notifying the reception apparatus, when the judging means judges that the measured value of the electric field strength is smaller than the threshold value, and the reception apparatus comprising: storage means for storing, in correspondence, identification data

Art Unit: 2682

identifying one or more mobile phones registered in the security company in advance and countermeasure data showing a countermeasure to be executed for each mobile phone; and specifying means for specifying the identification data of the mobile phone upon receiving the notification from the mobile phone, and for specifying countermeasure data which corresponds to the mobile phone by referring to the correspondence between the identification data and the countermeasure data.

Claims 30-32 depends from claim 29 and are therefore allowable based on this dependence. When incorporating all the limitations of the base claim and any intervening claims, none of the prior art discloses the features as claimed.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lewis G. West whose telephone number is 703-308-9298. The examiner can normally be reached on Monday-Friday 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 703-308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 2682



Lewis West  
(703) 308-9298



VIVIAN CHIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600